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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/533,515	05/02/2005	Gerald Eckert	DE02 0245 US	4545

24738 7590 11/13/2006

PHILIPS ELECTRONICS NORTH AMERICA CORPORATION  
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EXAMINER

ARANI, TAGHI T

ART UNIT	PAPER NUMBER
2131	

DATE MAILED: 11/13/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/533,515

Applicant(s)

ECKERT ET AL.

Examiner

Taghi T. Arani

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 02 May 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
- Paper No(s)/Mail Date 05/02/2005.

- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_.

Taghi T. Arani  
Principal Examiner  
11/8/06

### DETAILED ACTION

1. Claims 1-10 have been examined and are pending.

#### *Claim Rejections - 35 USC § 101*

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. Claims 1-4, 6-8 are rejected under 35 U.S.C. 101 because the claimed invention lacks patentable utility. The claimed invention is directed to “detecting point correspondences” and “finding possible matching pairs” which in and of itself does not constitute a specific and substantial utility.

Claims 1-4, and 6-8 are rejected under 35 U.S.C.101 because the claims are directed to a non-statutory subject matter.

The Federal Circuit has recently applied the practical application test in determining whether the claimed subject matter is statutory under 35 U.S.C. 101. The practical application test requires that a “useful, concrete, and tangible result” be accomplished. An “abstract idea” when practically applied is eligible for a patent. As a consequence, an invention, which is eligible for patenting under 35 U.S.C. 101, is in the “useful arts” when it is a machine, manufacture, process or composition of matter, which produces a concrete, tangible, and useful result. The test for practical application is thus to determine whether the claimed invention produces a useful, concrete and tangible results.

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Claims 1-4, and 6-8 are directed to “detecting point correspondences” and “finding possible matching pairs”. There is no showing in the claims that the claims are for “practical application” and what, if any, the final result is used for. Merely “finding a maximum number of matching pairs” does not meet the statutory requirement of 35 U.S.C. 101. For an invention to be useful it must satisfy the utility requirement of section 101. The utility requirement provides that the utility of an invention has to be (i) specific, (ii) substantial and (iii) credible. MPEP2107 and Fisher, 421 F.3<sup>rd</sup>, 76 USPQ2d at 1230.

Therefore, 1-4, and 6-8 are not for practical application that produces a useful result and are rejected under this section.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1, 5, 6, 9, and 10 are rejected under 35 U.S.C. 102(b) as being anticipated by US patent 5,631,972 (IDS filed 05/02/2005) to Ferris et al. (hereinafter “Ferris”).

As per claims 1, 5, 6, 9 and 10, Ferris teaches a method of detecting point correspondences between a first set of points and a second set of points ( Figs 7 and 12), comprising the following steps:

finding of possible matching pairs comprising a point from the first set of points and a point from the second set of points (col. 7, lines 54 through col. 8, line 7), and

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finding a maximum number of matching pairs (col. 8, lines 50-60, col. 10, lines 8-16, lines 40-62).

Ferris teaches wherein the point from the first set of points and the point from the second set of points are each points of note on fingerprint lines (col. 5, lines 61 through col. 6, line 16), the first set of points corresponding to a scanned fingerprint (col. 6, lines 24, i.e. search prints image), the second set of points corresponding to a reference fingerprint (col. 6, line 26, i.e. file prints), the points of note on the fingerprint lines in the scanned fingerprint allowing to be matched with the points of note in the reference fingerprint, and the method being a method of fingerprint verification in which the scanned fingerprint is compared with the reference fingerprint ( Figs. 1 and 1A and associated texts, see also col. 6, lines 23-27) .

#### **Conclusion**

**4. Prior arts made of record, not relied upon:**

US 5,761,330 to Stoianov et al.

Us 5,054,090 to Knight et al.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Taghi T. Arani whose telephone number is (571) 272-3787. The examiner can normally be reached on 8:00-5:30 Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ayaz Sheikh can be reached on (571) 272-3795. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Taghi T. Arani, Ph.D.

Primary Examiner

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11/8/2006